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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,920	11/26/2003	Donald G. Russell	98005.00012	1172
7590 11/17/2005 McCarter & English LLP CityPlace I 185 Asylum Street Hartford, CT 06103-3495			EXAMINER GUADALUPE, YARITZA	
			ART UNIT 2859	PAPER NUMBER

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,920

Applicant(s)

RUSSELL, DONALD G.

Examiner

Yaritza Guadalupe McCall

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to Amendment filed August 17, 2005

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 - 3 and 11 are rejected under 35 U.S.C. 102 (b) as being anticipated by
Michelson (US 4,985,019).

With respect to claim 1, Michelson discloses a marker comprising a substrate (10)
having at least one portion with an adhesive backing (30) and further having at least one portion
having indicia (See Figure 2) for identifying or measuring details of an area on which the
marker is to be overlaid.

In regards to claim 2, Michelson teaches a marker wherein the substrate comprises a first portion and a second portion, the first portion having a surface with an adhesive backing (30), the second portion (14) having the indicia for identifying or measuring details of a surface.

Regarding to claim 3, Michelson further shows a marker wherein the indicia comprises a target sight (See Figure 2).

In regards to claim 11, Michelson further teaches a marker wherein the target sight comprises at least two orthogonal line segments (See Figure 2).

3. Claims 29 and 32 - 33 are rejected under 35 U.S.C. 102 (b) as being anticipated by Smolen (US 4,015,034).

In regards to claim 29, Smolen discloses an apparatus comprising a light transmitting substrate for providing an image, i.e., register sheets; a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent and without adhesive backing thereby allowing the second portion to be lifted from the light transmitting substrate, without the need to lift the adhesive backed portion. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

With respect to claim 32, Smolen teaches an apparatus comprising a light transmitting substrate, i.e., register sheets; and a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent and has a target sight (15) inscribed thereon (See Figure 4).

Regarding claim 33, Smolen discloses an apparatus comprising a light transmitting substrate, i.e., register sheet; and a removable marker (10) having a first portion with adhesive backing (12) for attachment to the light transmitting substrate and further having a second portion (S, S') that is substantially transparent, wherein at least one of the first portion and the second portion includes a gauge portion defined by a target area (15).

4. Claim 34 and 41 - 42 are rejected under 35 U.S.C. 102 (b) as being anticipated by Bedford Jr. (US 4,951,595).

With respect to claim 34, Bedford Jr. discloses an apparatus comprising a light transmitting substrate, i.e., X-ray, for providing an image; and a removable marker (10) having a first portion with adhesive backing (11) for attachment to the light transmitting substrate and further having a second portion (13) that is substantially transparent and includes a surface (13) that could receive writing, if so desired by the user.

Regarding claim 41, Bedford Jr. teaches a method for marking an area of interest on a diagnostic image comprising the steps of providing a diagnostic image, i.e., X-ray, and marking an area of interest on the diagnostic image using a marker (See Column 2, lines 44 – 45) comprising a substrate (10) having a first portion and a second portion, wherein the first portion has a surface (11) with an adhesive backing (14) and the second portion is substantially transparent and has indicia (arrow 13, or hand writing if desired by the user) for identifying the area of interest on the diagnostic image.

In regards to claim 42, Bedford Jr. further discloses a marker comprising a substrate having a first portion and a second portion, wherein the first portion has means (11) for releasably adhering the substrate to a diagnostic image, i.e., X-ray, and the second portion has means (indicia) for identifying an area of interest on the diagnostic image.

5. Claims 1 and 40 are finally rejected under 35 U.S.C. 102 (b) as being anticipated by Riordan (US 6,063,225).

With respect to claim 1, Riordan discloses a marker comprising a substrate (41) having at least one portion with an adhesive backing (40a) and further having at least one portion (34) that is substantially transparent and has indicia (See Figure 5) for identifying or measuring details of an image on which the marker is to be overlaid.

In regards to claim 40, Riordan also discloses an apparatus comprising a holder (50); and a plurality of markers releasably mounted in the holder (See Column 4, lines 21 – 34).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riordan (US 6,063,225) in view of Bedford Jr. (US 4,951,595).

In regards to claim 29, Riordan discloses an apparatus comprising a substrate for providing an image (42); a removable marker (40) having a first portion with adhesive backing (40a) for attachment to the substrate and further having a second portion (41, 34) that is substantially transparent and without adhesive backing thereby allowing the second portion to be lifted from the substrate, without the need to lift the adhesive backed portion. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Riordan does not disclose the light transmitting substrate as stated in claim 29.

In regards to claim 29 : Bedford Jr. discloses a marker (10) for use in light transmitting substrates such as x-rays, so that the marker is temporarily secured on said light transmitting substrate to mark a point of interest. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teachings of Bedford et al. and Riordan in order to provide a reusable marker that temporarily secures on said light transmitting substrate to mark a point of interest as suggested by Bedford Jr.

Regarding claims 30 and 31, Riordan and Bedford Jr. teach the image being a diagnostic image and wherein the light transmitting substrate is an x-ray film.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson (US 4,985,019).

Michelson discloses a marker as stated in paragraph 2 above.

Michelson does not disclose the squares having a dimension of 1 cm as stated in claim 13.

With respect to claim 13 : Michelson discloses a marker wherein the target sight comprises a grid pattern having a plurality of squares having side dimensions of about 2 – 3 mm (See Column 1, line 68). To make a square having a diameter of 1 cm, is only considered to be the “ optimum ” value of the diameter for the square, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a square having a diameter of 1 cm in order to provide enhance the visibility of the target different color surfaces or different light intensity.

9. Claims 1 – 7, 11 - 12 and 14 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson II (US Pub. No. 2003/0182815) [Hereinafter Carlson].

With respect to claim 1, Carlson discloses a marker comprising a substrate (10) having at least one portion with an adhesive backing (16) and further having at least one portion that has indicia (See Figure 2) for identifying or measuring details of an area on which the marker is to be overlaid.

In regards to claim 2, Carlson teaches a marker wherein the substrate comprises a first portion and a second portion, the first portion having a surface with an adhesive backing (16), the second portion (14) having the indicia for identifying or measuring details of a surface.

Regarding to claim 3, Carlson further shows a marker wherein the indicia comprises a target sight (See Figure 2).

With regards to claim 4, Carlson discloses a marker wherein the target sight substantially defines a perimeter around a region of the second portion.

In regards to claim 5, Carlson also teaches a marker wherein the target sight focuses a reader's attention on a region of the image. However, the claimed limitation of claim 5, fails to further limit the subject matter, since it merely recites a functional statement and does not defines a particular feature or structure.

Regarding claim 6, Carlson shows a marker wherein the target sight substantially surrounds a region of the second portion.

With respect to claim 7, Carlson teaches a marker wherein the target sight comprises at least one circle.

In regards to claim 11, Carlson further teaches a marker wherein the target sight comprises at least two orthogonal line segments (See Figure 2).

Regarding claim 15, Carlson also shows a marker wherein the second portion has a substantially adhesive free backing (free of any adhesive).

Regarding claims 16 – 21 and 27, Carlson also shows a marker comprising a note portion (26) that is not transparent; wherein the note portion comprises a surface adapted to receive ink writing; wherein the note portion also includes a plurality of substantially parallel lines (See Figure 2); said note portion overlays the first portion and the note portion comprises a paper surface to receive writing.

In regards to claim 28, Carlson also discloses a releasable sheet (18) disposed on the adhesive backing.

Carlson does not disclose the substantially transparent portion as stated in claims 1. Carlson does not disclose the particular diameter for the target circle as stated in claims 8 – 10. Carlson does not disclose the square as stated in claim 12 and the line segments disposed on one or more lines bisecting the circle as stated in claim 14. Carlson does not disclose the specific indicia as stated in claims 22 – 26.

In regards to claim 1 : Carlson discloses a marker made of incise material, but does not specifies transparency characteristics. The particular type of material used to make the marker, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a transparent portion on said marker in order to increase the accuracy of the marking by increasing the contrast between the indicia and the surface to be marked.

With respect to claims 8 – 10 : Carlson discloses a marker having a target comprising at least one circle but fails to disclose the particular diameter. To make a circle having a diameter of 1, 2, and/or 4 inches, is only considered to be the “ optimum ” value of the diameter for the circle, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art

at the time the invention was made to provide a circle having a 1 inch, 2 inches or 4 inches diameter in order to provide a visible target that's easy to read and localize on different color surfaces or different light intensity.

In regards to claims 12 and 14 : Carlson discloses a marker having a target defining a circle. The use of a square on the target, absent any criticality, is only considered to be obvious modifications of the shape or configuration of the target shape disclosed by Carlson as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Regarding claims 22 – 26 : Carlson discloses a marker having indicia inscribed on said marker. However, the claims neither define new features of structure nor new relations of printed matter to structure. The printed matter defined does not distinguish over the cited art, i.e., Carlson, in terms of patentability. In the present case, with respect to the reference markings comprising inscribed dimensions or graduations, the only functional relationship between the printed matter and the apparatus is that the reference markings are provided on at least a first side and a second side of the apparatus. However, there is nothing new and unobvious in the type of reference markings as demonstrated by Carlson. Mere claim of the type of reference markings provided on the apparatus are not the kind of “new and unobvious functional relationship ”

necessary for giving the printed matter patentable weight. See *In re Gulack*, supra, and *In re Miller*, 164 USPQ 46 (CCPA 1969).

Response to Arguments

10. Applicant's arguments with respect to claims 1 - 42 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Michelson does not disclose a marker for identifying or measuring details of an image as stated in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the marker by Michelson is clearly intended to serve as a marker for identifying and measuring the proper location and orientation of a needle to be used on a patient meeting the structural requirements of the claimed language and capable of being used to identify and measure details of an image or patient's skin to which is applied. Furthermore, the term "comprising" is an open ended term that does not exclude the presence of additional elements, i.e., hole to guide a needle. Therefore, the fact that Fincher discloses additional structures not claimed is not persuasive.

It should be emphasized that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphases in original). To emphasize the point further, the court added: "An invention need not operate differently than the prior art to be patentable, but need only be different" (emphases in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention.

In regards to claims 34 and 41 - 42, applicant contends that the Bedford Jr. reference fails to teach a first portion including a paper surface for receiving writing. This argument is not persuasive because, as well understood by the examiner, any piece of material is capable of receiving writing indicia when a marking implements is used on its surface, if so desired by the user.

With respect to the Riordan reference as applied to claims 1 and 40, applicant contends that Riordan fails to disclose indicia for identifying or measuring details of an image. This argument is not persuasive because the marker shown by Riordan is clearly used to identify details (i.e., content) of an image (i.e., document # 42 as shown in Figure 5). Furthermore, a

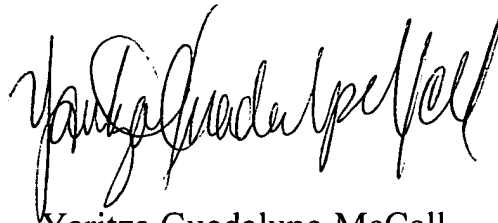
recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the marker by Riordan clearly serves as a marker for identifying and measuring details of an image/document, therefore meeting the structural requirements of the claimed language.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe McCall whose telephone number is (571)272-2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Yaritza Guadalupe-McCall', is positioned above the printed name.

YGM
November 14, 2005

Yaritza Guadalupe-McCall
Patent Examiner
Art Unit 2859